



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,009	01/27/2000	Hidehiro Ishii	P7156-9069	9342

7590 04/26/2004

ARENT FOX KINTNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVENUE N W
SUITE 400
WASHINGTON, DC 20036

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
----------	--------------

2615

DATE MAILED: 04/26/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,009

Applicant(s)

ISHII ET AL.

Examiner

HUY T NGUYEN

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 20 is objected to because of the following informalities: There is no antecedent basis for "The information recording system ". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 9-14 and 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 9-12 direct to stored information on medium. The information does not provide functional inter-relationship between the information and the medium use to control accessing the information from the medium or impart to any store software and hardware components to provide certain function that is processed by a computer, the stored information do not make themselves statutory. See MPEP 2100.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

Art Unit: 2615

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The new recitation of "logical units" is not described and explained the specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 9-10, 12-13, 15-16, 18-19, 21-22 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al (5,966,495).

8. Regarding claim 9, 12, 15, 18, 21 and 24, Takahashi discloses a recording system for recording a data structure on a recording medium, the data structure comprising: a record information area having record information, a first identifying information area having first identifying information, and a second identifying information area having second identifying information on the recording medium, wherein the record information includes 1) a plurality of first recording units (video unit or audio unit) 2) one or more second recording units (AV block) each of which contains one or more the first

Art Unit: 2615

recording units and 3) one or more logical units (AV logically erased block) each of which consists of one or more the first recording units, wherein the first identifying information corresponds to each of the one or more second recording units and specifies an editing state of a corresponding second recording unit (erasing or deleting state) , wherein the second identifying information corresponds to each of the one or more logical units and specifies an editing state (inserting state) of a corresponding logical unit (Fig. 21),

Regarding claim 10,13, 15, 19, 23 and 25 , Takahashi further teaches the first identifying information indicates whether a corresponding second recording unit is in a logically erased state (deletion state) (fig. 23) .

9. Claims 9-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kikuchi et al (6,577,811).

Regarding claim 9, 12, 15, 18, 21 and 24, Kikuchi discloses a recording system for recording a data structure on a recording medium, the data structure (Figs 19 and 23) comprising: a record information area having record information, a first identifying information area having first identifying information, and a second identifying information area having second identifying information on the recording medium, wherein the record information includes 1) a plurality of first recording units 2) one or more second recording units each of which contains one or more the first recording units and 3) one or more logical units each of which consists of one or more the first recording units, wherein the first identifying information corresponds to each of the one or more second recording units and specifies an editing state of a corresponding second recording unit

Art Unit: 2615

(Fig. 23) , wherein the second identifying information corresponds to each of the one or more logical units and specifies an editing state (Fig. 19) of a corresponding logical unit

Regarding claims 10, 13,16,19,22 and 25, Kikuchi further teaches that the first identifying information indicates whether a corresponding second recording unit is in a logically erased state (Fig. 23)

regarding claim 11, 14,17,20,23 and 26 , Kikuchi further teaches the second identifying information indicates whether a corresponding logical unit is to be protected (Fig. 19) .

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2615

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T NGUYEN whose telephone number is (703) 305-4775. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY T NGUYEN
PRIMARY EXAMINER